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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,522	09/08/2003	Raymond Bertholet	88265-6925	1947
29157 7590 01/23/2007 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER SILVERMAN, ERIC E	
			ART UNIT	PAPER NUMBER
			1615	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/23/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

T4

<b>Office Action Summary</b>	Application No. 10/658,522	Applicant(s) BERTHOLET ET AL.	
	Examiner Eric E. Silverman, PhD	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 10/13/2006 and 11/27/2006 have been entered.

Claims 1 – 19 are pending.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 17 of

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copending Application No. 10/526,576. Although the conflicting claims are not identical, they are not patentably distinct from each other because while copending application requires the process step of mressing the biomasses in the dry state, this is not required by instant claims. However, since instant claims use open "comprising" language, copending claims are merely a species of instant genus claims, thus rendering instant claims obvious in their entirety.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 – 3, 5 – 7, 9, 12, 13, 14 – 19 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermann, US 6,177,580 in combination with Barclay, EP 0726321 for reasons of record and those discussed below.

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive.

Applicants' argue that the references are directed to different arts, since they teach different processes for making their final products. However, both references are directed to making dietary lipids useful in foods, infant formulas, and the like, and thus are analogous art. That they take different approaches to solve this problem is not germane.

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Applicants further submit that the Timmermann references teaching of heating would render the microorganisms in Barclay unsuitable to perform its intended function. This argument is only applicable to process claims 7 – 13, since the product of the remaining claims need not be made by the process that Applicants' aver would be impossible to carry out. In response, there is no evidence of record to support Applicants' assertion. Arguments cannot take the place of evidence of record.

Applicants also argue that the references do not teach the incorporation of PUFAs such that at least 60% of the long chain PUFAs in the biomass are present in the carrier oil but that less than 10% of the phosphorous is so present. This is not persuasive, because the teaching of high yield in Timmermann is understood to mean greater than 60%, and also because no phosphorous is noted in any of the products when they are analyzed, thus, such is understood to be absent.

Applicants also argue that in the present invention, and contrary to the art, the carrier oil is used to selectively displace the biomass oil from a milled biomass. This limitation is not present in the claims, and thus is not a basis for patentability.

Claims 9 and 10 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermann, Barclay and Todd. Upon consideration, claim 8 is no included in this rejection.

Claim 8 includes the additional step of grinding the biomass. Todd teaches that grinding biomasses before extraction by an edible oil is desired because coarse particles in the residual solid cake can thus be avoided.

Thus, it would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to grind the biomass of Timmermann and Barclay as taught by Todd. The motivation is to avoid solid particles in the cake.

***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive.

Applicants' argue only that Todd does not rectify the alleged deficiencies of Timmermann and Barclay. These supposed deficiencies have been addressed, *supra*.

Claim 10 **remains** rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermann, Barclay, and Tsujiwaki for reasons of record and those discussed below. Upon consideration, claim 11 is also included in this rejection for reasons of record.

***Response to Arguments***

Applicants' have not addressed this rejection in their response. It must therefore be maintained.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermann, Barclay and Kyle, US 5,407,957.

The claim specifies that DHA be the stable oil.

The teachings of Timmermann and Barclay are discussed above.

What is lacking is a teaching of hocosahexanoic acid (DHA).

Kyle teaches that DHA is useful in foods, such as infant formula (col. 1 line 54 – col. 2 line 5). This is noted to be the same use as noted by the art of record for arachadonic acid. Kyle teaches a method of preparing this oil from a biomass, which is

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quite similar to the method used by Barclay to prepare arachadonic acid except that a different organism is used (col. 2 – 3).

It would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to use the DHA of Kyle in place of or in addition to the arachadonic acid of Barclay, thus giving the product of instant claim 4. The motivation is that these nutrients are both recognized in the art as food additives for the same purpose and to the same types of food products (such as infant formula).

### ***Conclusion***


No claims are allowed. No claims are free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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